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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 673,105	10-10-2000	Armin Labatzke	P00.1774	7683

7590 09-11-2002

Schiff Hardin & Waite
Patent Department
7100 Sears Tower
Chicago, IL 60606-6473

EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/673,105

Applicant(s)
Labatzke

Examiner
Tuyen T. Nguyen

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2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 4, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16 is/are pending in the application.
- 4a) Of the above, claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this Notice of Status.
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1. ☒ Notice of References Cited (PTO 892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO 943)
3. ☒ Information Disclosure Statement(s) (PTO-1449) Paper No. 6
4. ☐ Interview Summary (PTO 114) Paper No. _____
5. ☐ Notice of Informal Patent Application (PTO 152)
6. ☐ Other _____

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DETAILED ACTION

Election/Restriction

1. Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claimed method, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.
2. Applicant's election with traverse of the restriction in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the manufacturing process is not distinct from the apparatus. This is not found persuasive because the method steps clearly involve processes not necessary for the manufacture of the apparatus.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

Regarding claim 1, lines 6-7, applicant should clarify what structure is intended by "does not proceed." In lines 8-9, applicant should clarify the structure of the "conductive connections between

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said metallized surfaces and said contact surfaces.” Applicant should clarify whether the metallized surfaces are also contact surfaces. Claims 2-12 inherit the defects of the parent claim.

Regarding claim 3, applicant should clarify the intended structure of “the surfaces not proceeding parallel to the common plane...” There is no antecedent basis for “the surfaces.”

Regarding claim 4, line 3, the phrase “proceeding at an angle” is unclear.

Regarding claim 6, applicant should clarify the arrangement and locations of the “depressions.”

Regarding claim 10, line 3, it is unclear whether applicant intends the contact surfaces to be the same contact surfaces as those recited in claim 1. In line 4, the phrase “whereby” is unclear because it has been held that the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). In lines 5-7, applicant should clarify the co-planarity, spacing and heights of the contact surfaces relative to each other. The intended structure is unclear.

Regarding claim 11, line 3, it is unclear what applicant intended by “proceeding parallel to.” Applicant should clarify the structure and arrangement of the “conical frustum” and its relationship to components/surfaces of the carrier element.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action.

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-4, 10, as best understood in view of the rejection under 112 second paragraph, are rejected under 35 U.S.C. 102(b) as being anticipated by Gogal [US 4,288,841].

Gogal discloses a ceramic carrier member [100] comprising:

- at least two walls [see figure 2] connected with a common plane;
- an electronic element [25] disposed within the carrier member;
- at least two metallized contact surfaces [106] electrically insulated from one another and disposed on the common plane of the carrier member;
- further metallized surfaces [106] disposed on at least one surface of the carrier member perpendicular with the common plane;
- channels/grooves [103]; and
- conductive connections between the metallized contact surfaces and the further metallized surfaces [see figure 1].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 2, 5-9 and 11-12, as best understood in view of the rejection under 112 second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogal in view of Machado [US 6,225,560].

Gogal discloses the instant claimed invention except for the channels/grooves not being metallized, the electronic component being an inductor and leads of the electronic component being connected with the further metallized surfaces.

Machado discloses a carrier member for supporting an inductor connected to terminal portions mounted on external walls of the carrier and including a plurality of non-metallized channels [see figure 6] extending perpendicular to a planar surface thereof.

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to use carrier design of Machado for the carrier member of Gogal for the purpose of facilitating mounting.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

before the final office action, if the response is after final office action the fax number is (703)872-9319.

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Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *FIN*

September 9, 2002

Joyce T. Nizay